

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

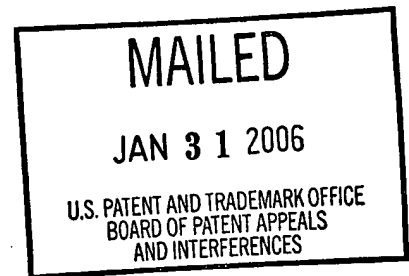
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRIAN M. MATTSON

Appeal No. 2006-0066
Application No. 09/560,067

ON BRIEF



Before KRASS, BARRETT and LEVY, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 9-14, 21, 22, 24, 25, and 27-29.

The invention is directed to a system for providing real-time restaurant reviews, best illustrated by reference to independent claim 9, reproduced as follows:

Claim 9. A method for transmitting real-time information regarding a restaurant by a patron of the restaurant, the method comprising the steps of:

providing a first apparatus having an input means wherein the input means
allows entry of the real-time information by the patron of the restaurant;

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inputting the real-time information into the input means of the first apparatus wherein the real-time information includes information regarding the restaurant; and

transmitting the real-time information to a destination remote from the restaurant.

The examiner relies on the following references:

CyberDiner Internet Café Systems website		Oct. 30, 1998
Blue Ginger webpage at Boston Globe website		Mar. 2000
Koether	5,875,430	Feb. 23, 1999
Lincke et al.	6,253,326	Jun. 26, 2001

Claims 9-14, 21, 22, 24, 25, and 27-29 stand rejected under 35 U.S.C. §103. As evidence of obviousness, the examiner offers CyberDiner and Blue Ginger with regard to claims 9-14, adding Koether to this combination with regard to claims 21, 22, and 24. With regard to claims 25 and 27-29, the examiner offers Lincke.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such

reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR §41.67(c)(1)(vii)].

With regard to independent claim 9, the examiner cites the CyberDiner system as comprising a restaurant with personal computers connected to the Internet for providing Internet access to restaurant patrons, with the restaurant “inherently” having within it, at each patron’s computer, an apparatus as claimed, but for the real-time information being entered into the apparatus comprising real-time information concerning the restaurant, such as a review of the restaurant. The examiner also notes that CyberDiner does not disclose posting the entered and transmitted real-time information at a website outside of the restaurant for viewing by persons outside of the restaurant.

The examiner relies on the Blue Ginger webpage at the Boston Globe website showing information concerning a restaurant (reviews of the restaurant) that has been entered over the Internet and posted at a website by patrons of the restaurant. The examiner notes that Blue Ginger does not necessarily require, or disclose, that the information entered was entered while the patron was still in the restaurant.

The examiner concludes that it would have been obvious to have used the teachings of CyberDiner and Blue Ginger simultaneously, so as to post a review as quickly as possible, while the dining experience was still fresh in the mind of the patron.

It appears to us that the examiner has presented a prima facie case of obviousness with regard to the subject matter of instant claim 9 by pointing out the disclosure of the prior art (CyberDiner), the differences between the prior art and the instant claimed subject matter (lack of input information being specifically directed to information about the restaurant and lack of a specific teaching that the information is posted to an Internet website for viewing by persons outside the restaurant) and why it would have been obvious to modify the prior art (CyberDiner) to arrive at the claimed invention (because it was "well known" to post information about restaurants on Internet websites, as taught by Blue Ginger, and it would have been obvious to combine CyberDiner and Blue Ginger in order to post the restaurant review quickly while the experience was still fresh in the mind of the patron/reviewer).

Thus, the burden has been shifted to appellant to overcome the prima facie case with argument and/or evidence.

Appellant argues that whereas claim 9 requires a system for transmitting information regarding a restaurant in real time, CyberDiner merely teaches a system for providing terminals with Internet access within a business, such as a café, to patrons, along with electronic mailboxes. Blue Ginger, in appellant's view, is merely a website of the Boston Globe where a number of reviews are posted relating to the Blue Ginger restaurant. But, in appellant's view, neither of the cited references, either singly or in combination, discloses or suggests inputting or transmitting real-time

information regarding a restaurant. In fact, according to appellant, the references “teach away” from the claimed invention since Blue Ginger teaches transmitting information regarding a restaurant, which is not in real-time (brief-pages 13-14).

We do not find appellant’s argument convincing. If one has access to e-mail and the Internet, which appellant admits a user of CyberDiner’s apparatus does, we find no patentability in the specific content of the messages the user inputs. That is, what does it matter, in terms of patentability of the apparatus, whether the user/patron of the apparatus in CyberDiner e-mails a message to a friend regarding the weather or regarding the restaurant, or café, in which he/she is sitting? Once the apparatus and the capabilities are taught, as in CyberDiner, it matters not whether the text message sent to an e-mail box or over the Internet concerns a review of the restaurant/café or any other topic. The only difference is in the content of the message, not in the structure of the apparatus permitting such communication. See In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983), where the critical question was whether there exists any new and unobvious functional relationship between the printed matter and a substrate. In the instant case, there is clearly no unobvious functional relationship between the content of the message (printed matter) and the apparatus (substrate) which permits the sending of the message. One type of textual content (e.g., a restaurant review) would have been equally obvious over any other type of textual content, as far as the structure is concerned, because the content in no way changes the apparatus structure and/or function.

In any event, the examiner cites Blue Ginger which clearly teaches restaurant reviews on Internet websites. Taking this teaching together with the teaching of CyberDiner, permitting the transmission of information over the Internet, the skilled artisan would have found it obvious to post information on an Internet website from the restaurant, i.e., in “real-time.” While the content of the transmitted and posted message appears immaterial to the steps of the claimed method, the choices of message content would have been equally obvious to the artisan as any information desired, including restaurant reviews may be posted by a user.

Also, contrary to appellant's view, we find no "teaching away" by Blue Ginger's failure to teach a posting in other than real-time. The teaching by Blue Ginger is the posting of restaurant information on an Internet website. Blue Ginger is not concerned with the specific time at which the posting is made. The examiner has provided a reasonable basis for modifying such a teaching for the artisan to have posted a restaurant review in real-time, viz., more accuracy due to the experience being fresh in the user/patron's mind while the patron is at the restaurant, especially in view of CyberDiner's disclosure of apparatus at the restaurant for transmitting messages over the Internet. Yet, appellant has shown no error in the examiner's rationale by providing some argument or evidence showing some reason the artisan would not want to write a review in real-time in view of the teachings of the applied references. Blue Ginger's examples all appear to involve reviews of restaurants visited in the past, but there is certainly nothing within such teaching which would dissuade artisans from providing such reviews in real-time, while at the restaurant, especially in view of the examiner's well-reasoned motivation for doing so.

Accordingly, we will sustain the rejection of claim 9 under 35 U.S.C. §103.

Appellant also argues, with regard to claim 10, that neither CyberDiner nor Blue Ginger teaches or suggests transmitting the real-time information regarding the restaurant to a display means to be viewed by a person outside of the restaurant. We disagree. If, for the reasons supra, the combination of CyberDiner and Blue Ginger suggests the sending of information regarding a restaurant from the restaurant to an Internet website, this information is clearly available to other persons viewing the website and will be visible to those other persons on a display means.

Claim 11 further limits claim 9 by providing a network on which the real-time information is received and stored (clearly the Internet which CyberDiner discloses as being accessed from the restaurant) and retrieving the information from the network (a remote person viewing the website, or reading e-mail sent by the restaurant patron, retrieves the information from the network).

Appellant's argument that the references do not disclose or suggest receiving, storing, or retrieving real-time information regarding a restaurant, is not convincing. Clearly, in sending an e-mail to a

friend from the restaurant, about the restaurant, a patron is causing such information to be received, stored and retrieved, and does this in real-time.

Claim 12 provides for a computer network (the Internet in CyberDiner) and the transmission of real-time information to the computer network (e.g., e-mailing a friend from a patron at the restaurant). For the reasons supra, the subject matter of claim 12 would have been obvious under 35 U.S.C. §103.

Claim 13 provides for the provision of a website and the posting of real-time information to that website. Again, since CyberDiner clearly suggests the use of and access to the Internet from the restaurant, the Internet clearly provides the website and any information posted on any website from a patron at the restaurant is posting of real-time information to that website. Accordingly, we find the subject matter of claim 13 to be obvious, within the meaning of 35 U.S.C. §103.

Claim 14 calls for the accessing of the real-time information via a computer. Clearly, any person viewing the website to which real-time information is posted by the restaurant patron is accessing the real-time information via a computer.

Thus, we will sustain the rejection of claims 9-14 under 35 U.S.C. §103.

Turning to claims 21, 22, and 24, the examiner applies CyberDiner and Blue Ginger, as above, in rejecting these claims under 35 U.S.C. §103, but the examiner also relies on Koether for a teaching of providing a wireless service, as claimed.

Appellant does not dispute the “wireless” teaching of Koether, or the obviousness of using a wireless connection in computer network communication. Rather, appellant makes the same arguments as with regard to claims 9-14, viz., information is not in “real-time;” information is not about the restaurant. For the reasons supra, appellant’s arguments are not persuasive, and we will sustain the rejection of claims 21 and 22 under 35 U.S.C. §103.

With regard to claim 24, appellant argues that this claim requires the wireless device to be a personal digital assistant and this is not taught or suggested by any of the applied references.

The examiner's rejection relies on CyberDiner's teaching of a personal computer to also include such personal computers as a personal digital assistant. At the very least, a personal digital assistant (PDA) would have been an obvious choice for the personal computer disclosed by CyberDiner, and this is nowhere disputed by appellant.

Accordingly, we will sustain the rejection of claim 24 under 35 U.S.C. §103.

Thus, we have sustained the rejections of claims 9-14 and of claims 21, 22, and 24 under 35 U.S.C. §103.

With regard to claims 25 and 27-29, however, we find otherwise.

We will not sustain the rejection of claims 25 and 27-29 under 35 U.S.C. §103 because the only reference relied on by the examiner for this rejection is Lincke. While Lincke is directed, in one example, to presenting a form on an Internet website and filling in that form with information regarding a restaurant, the example disclosed in Lincke (column 15) is directed to searching for a restaurant meeting certain criteria (e.g., city, cuisine). The user in Lincke cannot send information regarding a restaurant from the restaurant because the user in Lincke is not in the restaurant when filling out the form; rather, the user is searching for a restaurant he may have no knowledge of yet.

One might reasonably say that Lincke shows, in Figure 3, a form 105 which "includes information that the user implements to enter as the real-time information regarding the restaurant," as claimed. One might even reasonably contend that the information in Lincke's form 105 includes the food served at the restaurant (cuisine). However, one cannot reasonably contend that Lincke suggests "inputting the real-time information at the restaurant regarding the restaurant..." (emphasis ours), as required by independent claim 25, because at the time of inputting the information, the user is not at the restaurant; in fact, the user is searching as to which restaurant might suit his/her fancy.

Accordingly, the instant claimed subject matter (of claims 25 and 27-29) cannot be said to have been obvious, within the meaning of 35 U.S.C. §103, over Lincke.

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We do find it a bit curious that the examiner dropped the CyberDiner and Blue Ginger references, relying on Lincke alone, with regard to the rejection claims 25 and 27-29, rather than use the Lincke disclosure of an Internet form to be filled out in combination with the teachings of the other references regarding sending information from the restaurant. Whether a case of obviousness of the subject matter of claims 25 and 27-29 could have been made we cannot say. We do say, however, that the rejection of claims 25 and 27-29 under 35 U.S.C. §103, based on Lincke alone, cannot be sustained.

We have sustained the rejection of claims 9-14, 21, 22, and 24 under 35 U.S.C. §103, but we have not sustained the rejection of claims 25 and 27-29 under 35 U.S.C. §103.

The examiner's decision rejecting claims 9-14, 21, 22, 24, 25, and 27-29 under 35 U.S.C. §103 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(i)(iv).

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